



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,787	06/26/2003	Mihee Lee	033808-003	3464

21839 7590 01/09/2009  
BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
----------

ASTORINO, MICHAEL C

ART UNIT	PAPER NUMBER
----------	--------------

3769

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/09/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/603,787	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Michael C. Astorino	<b>Art Unit</b> 3769	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-32 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by a concrete result.

The claims lack a practical application because a useful, concrete, and tangible result is not produced. The claims do not produce a concrete result because they are not substantially repeatable. As stated in the previous office action as an example:

The claims assert an emotion induction protocol is capable of inducing a desired emotion, however an individual user of the device has their own subjective responses to any given stimuli, and individuals respond differently to the same stimuli. For example, using lavender as a stimulus maybe used to relax one user, but another user maybe allergic to the stimulus and not create the desired effect to relax a user. Additionally, a lavender scent maybe used to relax an individual on one day yet that same stimulus may not work in the same fashion if that same user has a cold an is unable to use their sense of smell in the same or similar manner.

Claims 1-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under 35 U.S.C. §101 a process must 1) be tied to another statutory class (such as a particular apparatus) or 2) transform underlying subject matter (such as an article or materials) to a different state or thing. The claimed process steps do not transform underlying subject matter. Thus, to qualify as a 35 U.S.C. § 101 statutory process, the claims

Art Unit: 3769

should positively recite the other statutory class (apparatus or thing) to which it is tied, for example by identifying the apparatus that accomplishes the method steps.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Since it is unclear if the modules are hardware or software, and what is required for the hardware and software, one of ordinary skill in the art would not know how to make or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regards to claim 1, it is unclear the examiner what structure the “emotion induction module,” “biostimulation module,” and “biosignal measurement module” requires. It is unclear to the examiner if the modules are software or algorithms, or if the modules require

Art Unit: 3769

structure. If the modules are software or algorithms the examiner suggests the applicant recite that the modules are on a computer readable medium, microprocessor, memory, or the like. The examiner cautions the applicant not to add subject matter to the claims that is not supported by the specification.

### ***Response to Arguments***

The following is repeated from the previous office action.

Applicant's arguments filed April 25, 2008 have been fully considered but they are not persuasive.

Applicant asserts that the claims are not rejectable under 35 U.S.C. 101, or 112.1 or, 112.2. The Examiner disagrees with the Applicant and relies on previous rejections and arguments. *Cited below in single space format.*

Applicant pointed out the guidelines for patent eligibility in the MPEP §2106 on pages 12 and 13 of the response. And as the Applicant correctly pointed out on page 14, lines 4-9, it is the examiner's belief that the claimed invention falls within the judicial exception; meaning a physical transformation must be produced, or a practical application must produce a "useful, concrete, and tangible result." The former does not apply and the latter standard is in question. Furthermore, the Applicant points accurately to the standard for the latter standard which requires a "useful, concrete, and tangible result," see the last paragraph of page 13 of the response.

In the previous office action the examiner did not accurately provide the rationale for the rejection, a "*specific and substantial asserted utility, a credible asserted utility or a well established utility.*" However examiner did provide a proper analysis under the "concrete prong of the test." As such the rejection under 35 U.S.C. 101 has been re-worded. As the Applicant has pointed out "[a] 'concrete' result is a result that can be substantially repeated," see page 13 of the response, lines 20-21.

Although, applicant did a through analysis on the previous office action based on an unclear 101 rejection, the applicant did not answer the question of whether a concrete result exists because it is repeatable. In fact, the Applicant states on page 16 in response to the previous office action's example that, "the user's allergic reaction *would likely be* reflected . . . which in turn *would likely* deviate . . ." (emphasis added). The Applicant chosen words reflect the examiner's point that the claimed invention is not concrete because it is not substantially

Art Unit: 3769

repeatable. The phrase “would likely” connotes that the claimed invention may or may not work properly as claimed and as such is not substantially repeatable.

The Applicant further argues on page 17, “[w]hether the user feels that the desired emotion has been induced need not be considered” however with respect to claim 15, the claim states “inducing the emotion” in the last limitation of the claim (see page 7 of the claims section). Additionally, “inducing the emotion” refers to the inducing a desire emotion claim 15, line 5, (see page 6 of the claims section.) Claim 1 suffers from the same issue, the claim states in line 7, an emotion induction module . . . configured to induce a desired emotion. It is the Examiner’s position that if Applicant claims a desired emotion is to be induced, that Applicant is able to produce a substantially repeatable induced desired emotion. It is the examiner’s position that “*would likely*” is not sufficient to be *substantially repeatable*.

Additionally, Applicant comments on pages 13-17 that the 101 rejection be withdrawn. However, the Applicant has not made a clear argument or provided any evidence as to how the claimed invention is *substantially repeatable*. As such the rejection will not be withdrawn. For the same rationale the rejection under 35 U.S.C. 112 is not withdrawn.

As for the 112.2 rejection, a “unit” is not a clear indication of structure. A “module” or “unit” may be a combination of hardware and software, but it is unclear to the examiner when “unit” applies to hardware or software. Although claim 3 uses the term unit to arguably impart structure, for example “storage unit” or “control unit”, for the emotion induction module, that does not necessarily require the biostimulation module or the biosignal measurement module to have structure instead of being software.

**The Applicant is invited to request an interview to discuss suggestions to advance the prosecution of the application.**

### ***Conclusion***

Art Unit: 3769

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Astorino whose telephone number is (571)272-4723. The examiner can normally be reached on Monday-Friday, 8:30AM to 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael C. Astorino/  
Primary Examiner, Art Unit 3769

January 5, 2009